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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/484,340	06/07/95	SMITH	243132000105

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18M2/0723

EXAMINER

TRAN, F

ART UNIT PAPER NUMBER

1807

DATE MAILED:

07/23/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/484,340**

Applicant(s)  
**SMITH ET AL.**

Examiner  
**Paul B. Tran**

Group Art Unit  
**1807**



☒ Responsive to communication(s) filed on May 6, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 73-107 and 109-132 is/are pending in the application.

Of the above, claim(s) 112-117 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 73-107, 109-111, and 118-132 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 16

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. The examiner acknowledges the receipt of Applicant's Amendment, Paper No. 18, filed May 6, 1997. Claim 108 was canceled; Claims 118-132 were added; Claims 76, 77, 82, 83, 105-107 and 109-111 were amended. The status of the claims is as follows: Claims 112-117 were non-elected and withdrawn from further consideration; Claims 73-107, 109-111 and 118-132 are pending before the examiner.
2. The rejection of claims 76, 77, 82 and 83 under 35 U.S.C. 112, second paragraph, as set forth in paragraph No. 4, is moot in view of Applicant's amendment. The rejection is hereby withdrawn.
3. The rejection of claims 105-107 under 35 U.S.C. 112, second paragraph, as set forth in paragraph No. 5, is moot in view of Applicant's amendment. The rejection is hereby withdrawn.
4. The rejection of claims 109-111 under 35 U.S.C. 112, second paragraph, as set forth in paragraph No. 6, is moot in view of Applicant's amendment. The rejection is hereby withdrawn.
5. The rejection of claims 73-75, 84-86, 89, 90, 101, 102 and 104 under 35 U.S.C. 102 (b), as anticipated by Draper et al., as set forth in paragraph No. 7, has been overcome by Applicant's

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amending the claims to recite an oligonucleotide, which is not anticipated by Draper et al. The rejection is hereby withdrawn.

6. The rejection of Claims 76-83, 87, 88, 91-100, 105-107 and 109-111 under 35 U.S.C. 103(a) as being unpatentable over Draper et al. in view of Sanger et al., as set forth in paragraph No. 8, has been overcome by Applicant's amending the claims to recite an oligonucleotide, which is neither taught nor suggested in Draper et al. The rejection is hereby withdrawn.

7. The judicially created doctrine of obviousness-type double patenting rejection of Claims 73, 74, 78-80, 84-87 and 89-91 over Claims 1, 4 and 7 of U.S. Patent No. 5,118,802, as set forth in paragraph No. 9, is maintained for the reason that Applicant defers a response to this rejection until an allowable subject matter is indicated. The rejection is hereby MAINTAINED.

#### **New Grounds of Rejections**

8. Claims 109-111 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims provide for the use of the oligonucleotide of claim 105 in a chain termination DNA sequencing reaction, but, since the claims do not set forth any steps involved in the method/process of using the oligonucleotide, it is unclear what method/process applicant is

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intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 73-107, 109-111 and 118-132 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ruth (U.S. Patent No. 4,948,882).

Ruth discloses an oligonucleotide tagged with a fluorescent via an amine linkage (col. 10, 19, 20; Example XXXII), which anticipates the structural limitations of the claims. However, the examiner can not determine whether or not the oligonucleotide disclosed in Ruth inherently possesses the property or function of the claimed oligonucleotides which anticipate or render obvious the claimed invention, thus shifting the burden of proof to Applicant as *In re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP 2112-2112.02.

11. Patent owner's amendment filed May 6, 1997, necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

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A shortened statutory period for response to this action is set to expire **3 months** from the mailing date of this action.

**Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings.** The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

**Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c).** A request for extension of time must be filed on or before the day on which a response to this action is due. The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.


The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

12. Any inquiry concerning this communication or those earlier from the examiner should be directed to Paul B. Tran, Ph.D., whose telephone number is (703) 308-4040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (703) 308-0196.

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Paper related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to the Chemical Matrix Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The facsimile numbers are (703) 305-3014 and (703) 305-4227. Information related to facsimile transmission should be directed to (703) 308-9378.

Paul B. Tran, Ph.D.   
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7/18/97

  
W. GARY JONES  
SUPERVISORY PATENT EXAMINER  
GROUP 1800

7/18/97